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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/041,416	03/12/98	SCHUSTER	A 4100-98DIV

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MM42/0812

EXAMINER

FUNK, S

ART UNIT

PAPER NUMBER

2854

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/041,416

Applicant(s)
Schuster et al.

Examiner
Stephen R. Funk

Group Art Unit
2854



☒ Responsive to communication(s) filed on Jun 29, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-10, 12-22, and 29 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-10, 12-22, and 29 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 8, 10

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Claims 1 - 10, 12 - 22, and 29 are objected to under 37 C.F.R. 1.75(a) as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 line 6 "for" should presumably be --by--.

Claim 29 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 29 it is not apparent how the "non-image locations" and "image locations" relate to the "picture" recited in parent claim 1 line 8. Note that in claim 1 the toner particles are fixed in accordance with "a picture" to be printed. Accordingly, it is not clear how the fixed toner particles in the "non-image locations" in claim 29 correspond to the fixed toner particles in the "picture" in claim 1, as "non image locations" would not appear to form a "picture".

Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 29 it is not clear how fixing the toner in the non-image locations and removing the toner from the image locations results in a functional printing form. Note that page 8 line 3 has been amended by applicant in the amendment filed 1/8/99 to state that the non-picture regions correspond to the regions where the layer "has been" removed. It is clear from the disclosure, in particular the sentence bridging pages 6 and 7, page 6 lines 7 - 8, and page 8 lines

4 - 8 that the "image" applied by the radiation to fix the toner corresponds to the "picture" to be printed and the regions where the toner is removed reveals a "non-image" hydrophilic layer. There is no clear support in the specification for a printing form operating in any other manner.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 - 10, 12 - 14, 19, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle (EP 099,264) in view Raschke et al. (US 3,921,527) and Calabrese et al. (US 4,705,696).

Doyle teaches the method as recited with exception of charging the printing form, applying "liquid" toner particles, and erasing the fixed toner particles after a printing process. Note that Doyle teaches on page 4 to electrostatically charge the toner to retain it on the form.

Raschke et al. teach the conventionality of charging the entire printing form, applying toner to the entire surface of the printing form, and erasing the fixed toner particles after a printing process. See the Abstract, column 3 lines 56 - 68, and column 5 lines 1 - 9 and 39 - 44 of Raschke et al.

Calabrese et al. teach the conventionality of applying and fixing liquid toner particles to a printing form. See the entire document of Calabrese et al.

It would have been obvious to one of ordinary skill in the art to provide the method of

Doyle with the step of charging the printing form and erasing the fixed toner in view of Raschke et al. as an alternative to charging the toner and to reuse the printing form and provide liquid toner particles in view of Calabrese et al. teaching the conventionality of such. With respect to claim 22 it would have been obvious to one of ordinary skill in the art to supplement the solvent erasing step of Raschke et al. with a brush or cloth to facilitate removal of the fixed toner particles.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle in view of Raschke et al. and Calabrese et al. as applied to the claims above, and further in view of Back (US 3,607,255). Back teaches the conventionality of hydrophilizing the regions not covered by the toner. See the Abstract of Back, for example. It would have been obvious to one of ordinary skill in the art to provide the method of Doyle, as modified by Raschke et al. and Calabrese et al., with the step of hydrophilizing the regions not covered by toner in view of Back so as to provide an adequately hydrophilic surface on the printing plate.

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle in view of Raschke et al. and Calabrese et al. as applied to the claims above, and further in view of Chu et al. (US 4,103,616). Chu et al. teaches the conventionality of crosslinking toner particles with UV radiation. See column 3 lines 2 - 23 of Chu et al. It is noted that lamps, including mercury, are conventional sources of UV radiation. It would have been obvious to one of ordinary skill in the art to provide the method of Doyle, as modified by Raschke et al. and Calabrese et al., with the step of crosslinking the toner particles with UV radiation in view of Chu et al. as an alternative to melting the toner particles with infrared radiation.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle in view of Raschke et al. and Calabrese et al. as applied to the claims above, and further in view of Peterson (US 4,020,762). Peterson teaches the conventionality of using a light source to ablate a carbon material from a printing plate. Carbon is a conventional material in toners. See column 1 lines 35 - 50 of Peterson. It would have been obvious to one of ordinary skill in the art to provide the method of Doyle, as modified by Raschke et al. and Calabrese et al., with the step of ablating the toner in view of Peterson as an alternative toner removing step.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle in view of Raschke et al. and Calabrese et al. as applied to the claims above, and further in view of Tomanek (US 3,650,797). Tomanek teaches the conventionality of removing toner from a printing plate with an alkaline solution. See the Abstract of Tomanek, for example. It would have been obvious to one of ordinary skill in the art to provide the method of Doyle, as modified by Raschke et al. and Calabrese et al., with the step of removing the fixed toner with an alkaline solution in view of Tomanek as a well known alternative solvent.

Claim 29 cannot be examined relative to the prior art at this time due to the indefiniteness addressed above.

Applicant's arguments filed 6/29/99 have been fully considered but they are not persuasive. With respect to applicant's arguments regarding claim 29 note that page 8 line 3 has been previously amended by applicant to delete "not". With respect to the prior art, applicant argues that neither Doyle or Raschke et al. teach applying liquid toner particles, Doyle does not teach erasing the printing form, and that Calabrese et al. do not teach the steps disclosed in

Doyle and Raschke et al. The alternative of using liquid, as opposed to dry, toner particles would appear to have been an obvious selection to one skilled in this art as each is known and the advantages and disadvantages would have been readily apparent. It is noted that applicant discloses on page 1 lines 11 - 12 that the prior art uses either dry or liquid toner particles and on page 8 lines 19 - 20 that the instant invention may use dry or liquid toner particles. Accordingly, the criticality of using liquid toner particles, other than that recognized by one of ordinary skill in the art, is not apparent. Lastly, applicant's acknowledgement that each of Doyle and Raschke et al. do not teach steps disclosed in the other does not point out any error in the proposed combination.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Funk whose telephone number is (703) 308-0982. The examiner can normally be reached on Monday - Thursday from 7:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Ren Yan, can be reached at (703) 308-0978. The fax number for incoming official papers is (703) 308-7722, 7724. The fax number for informal papers in Art Unit 2854 is (703)


Serial No. 09/041,416
Art Unit 2854

-7-

308-5841.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Stephen Funk
August 11, 1999



STEPHEN R. FUNK
PRIMARY EXAMINER